

REMARKS

Upon entry of this amendment, claims 1, 4 and 5 will be pending. Claim 1 has been amended; claims 4 and 5 are added.

Rejection under 35 U.S.C. §112

The preamble of the claim has been amended to clearly recite the fact that the chair and the microscope are part of the claimed combination.

Rejection under 35 U.S.C. §103

The Examiner rejected claim 1 based on a combination of six references:

- Jako
- Brambring
- Hoelzer
- Komura
- Wale
- Vaughn

The Applicant respectfully notes that the Examiner has cited Komura for showing the element “the microscope rotationally attached to the coupler along an axis that is perpendicular to the length of the terminal link and that lies within a plane which is perpendicular to the ground”. The Applicant respectfully submits that Komura does not show or suggest this element. Instead, Komura shows a rotational connection in which the pivot axis lies in a plane that is parallel to the ground. The Applicant’s arrangement allows side to side rotation of a mounted microscope that is not provided for in Komura. (This is in addition to the up-and-down rotation that is provided about the orthogonal axis in the terminal link.) Hence, the apparatus that would result from combining the references as suggested by the Examiner fails to include an element recited in claim 1.

The Applicant further submits that the Examiner’s application of six references for the rejection of the eight elements of claim 1 requires impermissible hindsight. Each of the references has addressed position-adjustability in their own preferred way, and therefore there is no suggestion to combine their many ways of achieving adjustability.

Claim 1 has been revised to clarify its scope and to point out that it is not a collection of individual and disjointed elements but rather a complete system incorporating hand controls, foot controls, angular relationships between the physician the microscope and the patent with speed and precision. The Examiner's primary contention in the obviousness rejection under §103 is that the "Jako reference discloses the claimed invention except for the limitation of the links being for restricting arm motion solely in a horizontal plane and a clamp." In the Examiner's view the Brambring reference teaches these elements and a person of ordinary skill in the art would have a motivation to combine them. However, the individual and isolated elements present in the prior art do not by themselves motivate the combination set forth in the amended claim. For example, there is no discussion in Brambring or Jako about using chair motion to reposition the patient providing fine focus control for the microscope. The elements are missing and the motivation to combine them is also missing. In Applicant's view the references do not show the elements of the claim nor do they provide any instruction to one of ordinary skill in the art to permit the claimed combination.

The Applicant has been successful in selling the system and customers have heaped praise upon the inventor suggesting that a long felt need by the physician community has been solved by the particular element set forth in the amended claim. For example, a Dr. Randall Klein wrote Dr. Cuomo, the inventor, indicating that he had been practicing for 25 years and was looking for a good solution to neck pain and shoulder pain which he has suffered. In a similar fashion a Dr. Michael Zelaya thanked Dr. Cuomo for a system which allowed him to eliminate the eye loops that he had been using for several years and found them heavy and he appreciates the freedom of not having to use them.

For these reasons the Applicant earnestly solicits granting of the application.

CONCLUSION

The prompt issuance of a notice to that effect is solicited.

Respectfully submitted,
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By his/her attorneys:

Date:

5/3/06

A handwritten signature in black ink, appearing to read 'R. Beck', written over a horizontal line.

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